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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,195	06/05/2001	James E. Christensen	YOR920010213US1	6833
7590	10/26/2004		EXAMINER	
Paul D. Greeley, Esq. Ohlandt, Greeley, Ruggiero & Perle, L.L.P. One Landmark Square, 10th Floor Stamford, CT 06901-2682			KRAMER, JAMES A	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/874,195	CHRISTENSEN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	James A. Kramer	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 6/28/04.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4,6-11,15-18,20-22,25-28,30-32 and 35-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4,6-11,15-18,20-22,25-28,30-32 and 35-50 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____.  | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,2,4,6,7,8,9,10,11 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's amendment has rendered these claims unclear. Examiner points to the first limitation:

"Developing a list of items to be returned by checking each of said items to be returned with a return policy of said business establishment and advising said customer of the likely return status of said listed items, said checking being performed by computing devices associated with a customer location that locally store said return policy"

Examiner notes that this is one method step, yet it is unclear who performs this step. In fact it appears that the step should require two different entities to accomplish. In particular, the consumer develops the list with a local computing device, however someone or something else does the step of advising, as it would be impossible for the consumer to advise the consumer.

Examiner advises breaking this method step into separate steps and further defining who performs the step.

For example:

Developing, by a user, a list of items to be returned by checking each of said items to be returned with a return policy of said business establishment, said checking being performed by computing devices associated with a customer location that locally store said return policy.

Advising, by said computing device, said customer of the likely return status of said listed items.

Examiner notes that this is how the claim will be interpreted in this Office Action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-18, 20-22, 25-28, 30-32, and 43-50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kunikyo.

Kunikyo teaches a computer network system (one or more networked computing devices).

Examiner further notes that these claims are apparatus claims which contain functional language. MPEP 2114 states that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In addition, an apparatus claims cover what a device is, not what a device does. The structure of Applicant's apparatus claims are one or more networked computing devices.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 6-11, 15-18, 20, 21, 22, 25-28, 30-32, and 35-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Junger (hereinafter Junger) in view of Halim et al. (Halim) in further view of Williams et al.

Junger teaches a method and apparatus for product return transactions that includes a return approval computer system utilizes product identifying information to determine whether a returned product satisfies applicable return criteria (column 2; lines 47-49). Junger further teaches a return approval location providing a list of approved returns and unapproved returns along with a return authorization or confirmation (column 2; lines 54-56). Junger teaches input devices and computing devices connected via the Internet (column 5; lines 9-12).

Junger teaches return criteria that includes temporal, usage or a dynamic rule that a business value condition must be satisfied (column 7; lines 7-14). Junger further teaches determining if one of the items needs to be physically returned and if not saving the cost of shipping by not returning the product (column 7; lines 13-17).

Junger teaches a data storage unit that stores data associated with the purchased items. In particular data is saved in regards to product identification, purchase location, date of return and quantity purchased. Junger teaches not only having this data available for mining but also mining the data in order to determine if a proper return is being made (column 6; lines 47-57).

Examiner notes the Junger teaches a business condition related to the warranty period, as explained in the rejection under USC 112 second paragraph, this is interpreted as an extrinsic business condition, as it does not relate to the item directly.

Junger teaches identifying information is sent to a remote return approval computer through the Internet. In other words, the system of Junger does not include a local return approval computer (checking being performed by a computing devise associated with a customer location that locally stores return policy). Halim teaches that it is old and well known for remote computers to keep local copies of data stored on a server (column 1; lines 64-66). Generally this is done in order to increase processing speed at the local computer.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the remote return approval computer system of Junger to include a local copy of this data stored locally to the consumer's computer in order to increase the processing speeds for the consumer.

#### *Response to Arguments*

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer  
Examiner  
Art Unit 3627

jak

*[Signature]*  
Richard Chilcot  
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